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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,330	09/04/2001	Vivek M. Sample	99-0067	2321

8840 7590 01/20/2004

ALCOA INC
ALCOA TECHNICAL CENTER
100 TECHNICAL DRIVE
ALCOA CENTER, PA 15069-0001

EXAMINER

LEE, EDMUND H

ART UNIT

PAPER NUMBER

1732

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/944,330

Applicant(s)

SAMPLE ET AL.

Examiner

EDMUND H. LEE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Lazzari (USPN 4911967) as set forth in the Office action mailed 8/13/03.

3. Claims 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakayama et al (USPN 4673602) as set forth in the Office action mailed 8/13/03.

4. Claims 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Gassaway (USPN 3607528) as set forth in the Office action mailed 8/13/03.

5. Claims 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Lazzari (USPN 4911967). Lazzari teaches the claimed process as evident by col 1, lns 5-7; col 2, lns 30-60; and figs 1-4.

6. Claims 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakayama et al (USPN 4673602). Nakayama et al teach the claimed process as evident by col 1, lns 10-15; col 2, lns 24-46; col 3, lns 12-25 and 35-36; col 4, lns 39-64; and figs 1-8.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lazzari (USPN 4911967) as set forth in the Office action mailed 8/13/03.
9. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakayama et al (USPN 4673602) as set forth in the Office action mailed 8/13/03.
10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gassaway (USPN 3607528) as applied to above claim 12 and further in view of Nakayama et al (USPN 4673602) as set forth in the Office action mailed 8/13/03.
11. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gassaway (USPN 3607528) as set forth in the Office action mailed 8/13/03.
12. Claims 16-20 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazzari (USPN 4911967). The above teachings of Lazzari are incorporated hereinafter. In regard to claims 16-18, Lazzari teaches using an aluminum wafer/substrate (col 2, ln 30). However, Lazzari does not teach using the claimed type of aluminum. The specific type of aluminum used is a mere obvious matter of choice dependent on the desired final product and material availability and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, the claimed types of aluminum are well-known in the disk art for their weight and durability. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the claimed type of aluminum as the

aluminum of Lazzari in order to produce a high-quality disk. In regard to claims 19-20, the specific thickness of the substrate is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, the claimed thickness is well-known in the disk art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made use a substrate with the claimed thickness in the process of Lazzari in order to reduce material costs without sacrificing quality. In regard to claims 22-23, the specific thickness of the polymer layer is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, the claimed thickness is well-known in the disk art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a polymer layer having the claimed thickness in the process of Lazzari in order to reduce material costs without sacrificing quality.

13. Claims 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakayama et al (USPN 4673602). The above teachings of Nakayama et al are incorporated hereinafter. In regard to claims 16-18, Nakayama et al teaches using an aluminum wafer/substrate (col 2, lns 24-25). However, Nakayama et al does not teach using the claimed type of aluminum. The specific type of aluminum used is a mere obvious matter of choice dependent on the desired final product and material availability and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, the claimed types of

aluminum are well-known in the disk art for their weight and durability. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the claimed type of aluminum as the aluminum of Nakayama et al in order to produce a high-quality disk. In regard to claims 19-20, the specific thickness of the substrate is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, the claimed thickness is well-known in the disk art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made use a substrate with the claimed thickness in the process of Nakayama et al in order to reduce material costs without sacrificing quality. In regard to claim 21, the specific type of polymer is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, polycarbonate is well-known in the disk art for its durability. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use polycarbonate as the polymer of Nakayama et al in order to produce a durable disk.

14. Claims 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gassaway (USPN 3607528). The above teachings of Gassaway are incorporated hereinafter. In regard to claims 16-18, the specific type of aluminum used is a mere obvious matter of choice dependent on the desired final product and material availability and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, the claimed types of

aluminum are well-known in the disk art for their weight and durability. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the claimed type of aluminum as the aluminum of Gassaway in order to produce a high-quality disk. In regard to claims 19-20, the specific thickness of the substrate is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, the claimed thickness is well-known in the disk art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made use a substrate with the claimed thickness in the process of Gassaway in order to reduce material costs without sacrificing quality. In regard to claim 21, the specific type of polymer is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, polycarbonate is well-known in the disk art for its durability. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use polycarbonate as the polymer of Gassaway in order to produce a durable disk. In regard to claims 22-23, the specific thickness of the polymer layer is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, the claimed thickness is well-known in the disk art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was

made to use a polymer layer having the claimed thickness in the process of Gassaway in order to reduce material costs without sacrificing quality.

15. Applicant's arguments filed 10/27/03 have been fully considered but they are not persuasive. Applicant argues that the use of "consisting essentially of" overcomes Lazzari, Nakayama et al, and Gassaway because these references use more than one layer of polymer. This argument is misplaced because applicant has not met the burden of showing that the additional steps would materially change the characteristics of the claimed invention. Furthermore, the instant specification at page 7, lns 8-9 discloses the polymer layer being single or a plurality of sub-layers; thus, it does not seem that additional layers of polymer would materially change the characteristics of the claimed invention. Applicant is advised to read MPEP 2111.03.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H. LEE whose telephone number is 571.272.1204. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 703.305.5493. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0661.

EDMUND H. LEE
Primary Examiner
Art Unit 1732


1/12/04

EHL